IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of   Atty. Docket

MAARTEN P. BODLAENDER ET AL.   PHNL 030276

Serial No.: 10/550,353   Group Art Unit: 2623

Filed: September 23, 2005   Examiner: F.S. Andramuno

                                    CONFIRMATION NO.: 1278

PLAYLIST SYNCHRONIZATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

<u>APPEAL BRIEF</u>

TABLE OF CONTENTS

(i)   <u>Real Party in Interest</u>

The real party in interest in this application is KONINKLIJKE PHILIPS ELECTRONICS N.V. by virtue of an assignment from the inventors recorded on September 23, 2005, at Reel 017798, Frame 0167.

(ii)   <u>Related Appeals and Interferences</u>

There are no other appeals and/or interferences related to this application.

(iii)   <u>Status of Claims</u>

Claims 1, 2, 6-8 and 10-12 stand finally rejected by the Examiner. Claims 3-5 and 9 have been cancelled. Appellants hereby appeal the rejections of claims 1, 2, 6-8 and 10-12.

(iv)   <u>Status of Amendments</u>

There was one Response filed on January 29, 2009, after final rejection of the claims on October 28, 2008, this Response having been considered by the Examiner.

Summary Of Claimed Subject Matter

   The subject invention relates to a user device for storing content items, for uploading a list of desired content items and for downloading these desired content items, and for selectively deleting content items in order to have sufficient storage capacity for the downloaded desired content items.

   In particular, the subject invention, as claimed in claim 1, relates to "A method of storing new content items in a memory unit *(Fig. 2, Ref. 12; page 4, line 21 to page 5, line 2)* of a user device capable of rendering said content items *(Fig. 2, Ref. 1; page 4, lines 1-5)*, the memory unit containing old content items, the method comprising the steps of:

   marking any old content items which may be deleted *(Fig. 4, Ref. 8; page 5, lines 10-20)*;

   generating a first list of new content items to be stored, said first list being compiled by a user *(Fig. 4, Ref. 9; page 5, lines 20-34)*;

   uploading said first list to a server for selecting the new contents items to be downloaded to the user device *(Fig. 1, Refs. 1-3; page 6, lines 1-2)*;

   determining a storage space required for each new content item to be stored *(page 6, lines 2-10)*; and

   deleting a marked content item only when necessary to release storage space for storing a new content item, so as to fill the memory unit substantially to capacity *(page 6, lines 10-15)*.

As claimed in claim 8, the subject invention includes "A computer-readable medium having recorded thereon a software program executable on a processor for carrying out the method according to claim 1." This is shown in Fig. 2, as memory unit 12, and described in the specification on page 4, lines 28-32, and on page 7, lines 12-16.

As claimed in claim 10, the subject invention includes "A user device for rendering content items *(Fig. 1, Ref. 1; page 4, lines 1-3)*, the device comprising a memory unit for storing content items *(Fig. 2, Ref. 12; page 4, lines 28-31)*, rendering means for rendering said stored content items *(Fig. 2, Refs. 13, 14; page 4, lines 22-25)*, and processor means *(Fig. 2, Ref. 11; page 4, lines 21-22 and 30)* for selectively storing new content items in the memory unit containing old content items, the processor means being arranged for:

marking any old content items which may be deleted *(Fig. 4, Ref. 8; page 5, lines 10-20)*;

generating a first list of new content items to be stored, said first list being compiled by a user *(Fig. 4, Ref. 9; page 5, lines 20-34)*;

uploading said first list to a server for selecting the new contents items to be downloaded to the user device *(Fig. 1, Refs. 1-3; page 6, lines 1-2)*;

determining a storage space required for each new content item to be stored *(page 6, lines 2-10)*; and

deleting a marked content item only when necessary to release storage space for storing a new content item, so as to fill the memory unit substantially to capacity *(page 6, lines 10-15)*.

The subject invention, as claimed in claim 11, further includes "A system for transferring content items, the system comprising a server for storing content items *(Fig. 1, Ref. 2; page 1, lines 9-10)*, at least one user device as claimed in claim 10, and transfer means *(Fig. 1, Ref. 3; page 4, lines 15-20)* for transferring content items from the server to the user device.

(A) Whether the invention, as claimed in claims 1, 2, 6 and 10, is
     unpatentable, under 35 U.S.C. 103(a), over U.S. Patent
     Application Publication No. 2002/0033960A1 to Kazami in view
     of U.S. Patent 6,868,225 to Brown et al.

(B) Whether the invention, as claimed in claims 7, 8 and 12, is
     unpatentable, under 35 U.S.C. 103(a) over Kazami in view of
     Brown et al., and further in view of U.S. Patent 6,628,963 to
     Chung.

(vii)   <u>Arguments</u>

35 U.S.C. 103(a) states:

    "(a)A patent may not be obtained though the invention
    is not identically disclosed or described as set forth
    in section 102 of this title, if the differences
    between the subject matter sought to be patented and
    the prior art are such that the subject matter as a
    whole would have been obvious at the time the invention
    was made to a person having ordinary skill in the art
    to which said subject matter pertains. Patentability
    shall not be negatived by the manner in which the
    invention was made."

(A) Whether Claims 1, 2, 6 and 10 Are Unpatentable

Over Kazami In View Of Brown et al.

The Kazami publication discloses an image recording apparatus
and method in which image files are recorded on a recording medium,
and in which monitoring means monitors the files on the recording
medium and causes certain of the recorded files to be deleted by
deleting means in accordance with certain criteria.

The Brown et al. patent discloses a multimedia program
bookmarking system.

A.1 Claims 1, 10

The subject invention, as claimed in claims 1 and 10,
includes the limitations "generating a first list of new content
items to be stored, said first list being compiled by a user" and
"uploading said first list to a server for selecting the new
contents items to be downloaded to the user device".

The Examiner has conceded that Kazami fails to teach
these limitation. The Examiner then states:

"Brown discloses in (figure 24) a list generated by a user. In addition, Brown teaches the invention provides a multimedia program bookmarking system. The system allows a user to save and retrieve bookmarks for several audio and/or video programs on a single device (column 1 lines 52-55). Moreover, Brown also discloses the system loads the associated bookmark information for the user. Any bookmarks that do not have associated programs stored on the storage device are ignored and deleted (column 2 lines 8-13).

"Therefore, it would have been obvious at the time of the invention to include the use of a generation of a content list and to further load them to a server. This is a useful combination because it allows a system to compile various forms of videos and tag them for later use."

Appellants submit that the Examiner is misinterpreting Brown et al. In particular, while Brown et al. discloses that the user is able to compile a list of programs to be recorded, there is no disclosure or suggestion of "uploading said first list to a server for selecting the new contents items to be downloaded to the user device". In fact, the "server" does not select the new contents items to be downloaded to the user device. Rather, the "server" autonomously transmits programs to the user device on various channels, the user device merely recording the selected program at its appointed time and channel of delivery. Further, while the Brown et al. system "allows a user to save and retrieve bookmarks for several audio and/or video programs on a single device", it should be noted that this all occurs on the user device, there being no transferring of information to a server, and the server uploading a program to the user device based on any list.

The Examiner now states "Brown discloses on (column 2 lines 9-13) a system capable of loading loading information of the user in a storage device. Moreover, Kazami discloses in figure 4 a system capable of uploading (presenting) an image file anticipated to be

deleted by the second automatic deleting means (6), and inquires as to whether the deletion operation of the image file is approved. This clearly shows a system that uploads image files for allowing a user to determine whether the data should be deleted or not (column 4 paragraph (0067))."

The portion of Brown et al. noted by the Examiner states: "The system loads the associated bookmark information for the user. Any bookmarks that do not have associated programs stored on the storage device are ignored and deleted. The invention plays back programs starting from the associated bookmarks, if they exist."

Appellants submit that it should be evident that Brown et al. is concerned with programs already recorded at the user device. There is no disclosure or suggestion of uploading a list of new content to a server, or the downloading from the server of the new content.

Kazami is generally described above. With regard to paragraph [0067] on page 4, Kazami states:

"[0067] Another aspect of the invention, shown in FIG. 4, further includes a user interface 4 for presenting an image file anticipated to be deleted by the second automatic deleting means 6, and inquires as to whether the deletion operation of the image file is approved. The second automatic deleting means 6 performs deletion of the image file if the deletion operation is approved via the user interface 4."

Appellants submit that it should be apparent from the above that the user interface 4 presents an image file anticipated to be deleted by the second automatic deleting means 6. However, from the Examiner's statement ("a system capable of **uploading (presenting)** an image file anticipated to be deleted" (emphasis added)), it is

also apparent that the Examiner does not understand the concept of "downloading" and "uploading". Appellants refer to the definitions of these terms given in SearchNetworking.com on a page last updated on July 27, 2001:

> "Downloading is the transmission of a file from one computer system to another, usually smaller computer system. From the Internet user's point-of-view, to download a file is to request it from another computer (or from a Web page on another computer) and to receive it.
> "uploading is transmission in the other direction, from one, usually smaller computer to another computer. From an Internet user's point-of-view, uploading is sending a file to a computer that is set up to receive it."

Hence, Appellants submit that the concept of "downloading" and "uploading" means more than merely the presenting of an image file.

This concept is indeed present in claims 1 and 10 in the limitation "uploading said first list [from the user device] to a server for selecting the new contents items to be downloaded [from the server] to the user device".

(B) Whether Claims 7, 8 and 12 Are Unpatentable
Over Kazami In View Of Brown et al., And Chung

The above arguments concerning Kazami and Brown et al. are incorporated herein.

The Chung patent discloses a portable multimedia player which includes a CD-ROM drive, memory 26 for storing MP3 files "downloaded by way of online communications" (col. 2, lines 55-59), and an MPEG audio section 62 for processing an audio signal, arguably from either memory 26 or from the CD-Rom drive.

However, Applicants submit that Chung does not supply that which is missing from Kazami and Brown et al., i.e., "uploading said first list to a server for selecting the new contents items to be downloaded to the user device".

Based on the above arguments, Appellants believe that the subject invention is not rendered obvious by the prior art and is patentable thereover. Therefore, Appellants respectfully request that this Board reverse the decisions of the Examiner and allow this application to pass on to issue.

Respectfully submitted,

by __/Edward W. Goodman/_____
Edward W. Goodman, Reg. 28,613
Attorney

(viii)   <u>Claims Appendix</u>

1. (Previously Presented) A method of storing new content items in a memory unit of a user device capable of rendering said content items, the memory unit containing old content items, the method comprising the steps of:

5   marking any old content items which may be deleted;

          generating a first list of new content items to be stored, said first list being compiled by a user;

          uploading said first list to a server for selecting the new contents items to be downloaded to the user device;

10   determining a storage space required for each new content item to be stored; and

          deleting a marked content item only when necessary to release storage space for storing a new content item, so as to fill the memory unit substantially to capacity.

2. (Previously Presented) The method as claimed in claim 1, wherein only as many marked content items are deleted as is necessary to store one new content item.

3-5. (Cancelled).

6. (Previously Presented) The method as claimed in claim 1, wherein the marked old content items are comprised in a second list, said second list being stored in the user device.

7. (Previously Presented) The method as claimed in claim 1, wherein each content item comprises a piece of music and/or a video clip.

8. (Previously Presented) A computer-readable medium having recorded thereon a software program executable on a processor for carrying out the method according to claim 1.

9. (Cancelled).

10. (Previously Presented) A user device for rendering content items, the device comprising a memory unit for storing content items, rendering means for rendering said stored content items, and processor means for selectively storing new content items in the

5   memory unit containing old content items, the processor means being arranged for:

marking any old content items which may be deleted;

generating a first list of new content items to be stored, said first list being compiled by a user;

10   uploading said first list to a server for selecting the new contents items to be downloaded to the user device;

determining a storage space required for each new content item to be stored; and

deleting a marked content item only when necessary to
15   release storage space for storing a new content item, so as to fill
the memory unit substantially to capacity.

11.   (Previously Presented) A system for transferring content
items, the system comprising a server for storing content items, at
least one user device as claimed in claim 10, and transfer means
for transferring content items from the server to the user device.

12.   (Previously Presented) The system as claimed in claim 11,
wherein the transfer means comprises the Internet.

(ix)   Evidence Appendix

     There is no evidence which had been submitted under 37 C.F.R. 1.130, 1.131 or 1.132, or any other evidence entered by the Examiner and relied upon by Appellant in this Appeal.

(x)   Related Proceedings Appendix

Since there were no proceedings identified in section (ii) herein, there are no decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of 37 C.F.R. 41.37.